

REMARKS

Claims 20-29, 50, 51, 71-80, 82-101, 116, 118, 120-126, 128-132 and 134-142 are allowed over the prior art of record. Claims 1-19, 30-49, 52-54, 65, 72, 81, 88, 102-115, 117, 119 and 127 were previously cancelled. Claim 89 is amended. No new subject matter is added. Reconsideration and allowance of the remaining rejected claims (claims 55-64, 66-70 and 133) is requested in light of the following remarks.

Request for Withdrawal of the Finality of the Office Action mailed 2 June 2005

In the Advisory Action mailed on 30 June 2005, the applicant's request for withdrawal of the finality of the office action mailed on 2 June 2005 was refused because claim 55 was amended to include subject matter that was recited in allowed claim 71.

The reasons for this refusal were 1) the subject matter imported from claim 71 did not constitute a feature of claim 71 that made the claim allowable and 2) the "*new matter*" that applicant added to claim 55 requires further consideration and/or search (emphasis added).

These reasons, however, do not meet the standard outlined in MPEP 706.07(d).

MPEP 706.07(d) states that on a second or any subsequent action on the merits should not be made final if it includes a rejection, on prior art not of record, of any claim amended to ***include limitations that which should reasonably have been expected to be claimed*** (emphasis added). There is no requirement that the amendment must include subject matter which was previously indicated to be allowable, only that the amendment should reasonably have been expected to be claimed. Since the feature that was added to claim 55 had already been claimed in claim 71, the applicant submits that it would be reasonable to expect that such a feature might be claimed in other claims as well.

Furthermore, since it has been characterized as such, the applicant respectfully submits the subject matter of claim 71 that was incorporated into claim 55 does not constitute new matter. This feature is fully supported by the original application, and therefore is not new matter.

As for the second stated reason, the applicant must assume that consideration and/or a search was already performed for the feature of claim 71 that recites "bonding wires directly connected to the portion of the inner leads" since during prosecution of the application ***all words in a claim must be considered*** in judging the patentability of that claim against the prior art. MPEP 2143.03, *citing In re Wilson*, 424 F.2d 1382, 1383 (CCPA 1970), emphasis added. If this feature was not one that made claim 71 allowable, then the results of the

previous consideration and/or search that was given for claim 71 must have resulted in the discovery of a prior art reference that allegedly teaches this feature.

Indeed, in the Advisory Action mailed on 9 June 2003 (Paper No. 13), it was stated that "[s]ince ... claim 71 does not recited [sic] the bonding wires are directly connected to the portion of the inner leads, ... claim[s] ... 71 do[es] not distinguish over Casto's reference" (emphasis in original). Subsequently, the applicant amended claim 71 to recite "directly connected," which resulted in a rejection of claim 71 in view of the Casto/Nokita combination. See, e.g., the office action that was mailed on 10 December 2003 (Paper. No. 20031001).

Thus, Nokita was apparently alleged to disclose the feature of bonding wires that are directly connected to the portion of the inner leads. Therefore, the applicant's amendment of claim 55 to include this feature did not require further consideration and/or search, and the Examiner's decision to perform additional consideration and/or search should not have resulted in a final office action to the detriment of the applicant.

Thus, the applicant again requests that the Examiner withdraw the finality of the office action that was mailed on 2 June 2005.

Allowable Subject Matter

Claims 20-29, 50, 51, 71-80, 82-101, 116, 118, 120-126, 128-132 and 134-142 are allowed over the prior art of record.

Claim 89 is amended to correct an error. In a previous response, the first word of the claim (the word "The") was mistakenly deleted.

The Noriyuki Reference

In the final office action, much of the rejections are substantially based upon JP-05-14469 to Noriyuki ("Noriyuki"). However, it appears that the reference that was provided to the applicant actually consists of a combination of two different publications. The first publication appears to be the paper publication of JP-05-14469. The second publication appears to be an electronic document that was retrieved from an online database or from the Internet, specifically, the Patent Abstracts of Japan (see, e.g., MPEP 705(e)(IV), examples 1-11).

MPEP 2128 states that if an electronic document which is the abstract of a printed publication is relied upon in a rejection under 35 USC 102 or 103, ***only the text of the***

abstract (and not the underlying document) may be relied upon to support the rejection (emphasis added).

The applicant takes this to mean that where the electronic document retrieved from the online or internet database is concerned, only the written text of the electronic document may be used to support the 103 rejection. Everything else, including the Figure associated with the abstract, is part of the underlying document.

Claim Rejections - 35 USC § 103

Claims 55-57, 59-64, 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noriyuki in view of U.S. Patent No. 6,198,171 to Huang, et al. ("Huang 171"). The applicant disagrees.

With respect to claim 55, Noriyuki is alleged to disclose both a die pad 1 having a uniform first thickness and inner leads (portion of lead 3) disposed inside the package body 5 that have a uniform second thickness that is greater than the first thickness.

Noriyuki does not disclose that FIGs. 1-3 are drawn to scale, it is silent as to the dimensions of the features shown in FIGs. 1-3, and it does not discuss the thickness of the die pad 1 compared to the leads 3. In such a situation, MPEP 2125 states that the proportions of the features shown in the drawings is not evidence of the actual proportions, and cannot be relied upon. Thus, no conclusion can be drawn from Noriyuki's disclosure regarding the relative thickness of the die pad 1 compared to the leads 3, and therefore, Noriyuki fails to teach the feature of inner leads having a uniform second thickness that is greater than the uniform first thickness of the die pad.

Furthermore, Noriyuki FIG. 3 illustrates a conventional semiconductor device, where the gold leads 4 are very close to being exposed above the upper surface of the mold resin 5 (Noriyuki, paragraph 0003). Noriyuki's invention is aimed at eliminating the identified problems of the conventional device by "mak[ing] small the level difference of the bonding pad section of the IC chip [2] and the lead [3] to which the gold streak [4] is connected." Noriyuki accomplishes this in two ways: either by forming "a level difference section 2a" as illustrated in FIG. 1 (paragraph 0008), or by forming "crevice 1a" in the die pad 1 as illustrated in FIG. 2 (paragraph 0009).

Contrary to claim 1, the embodiment of FIG. 1 does not illustrate that the inner leads 3 have a uniform second thickness that is greater than a uniform first thickness of the die pad 1. Contrary to claim 1, the embodiment of FIG. 2 does not illustrate that the die pad 1 has a

uniform first thickness at all. Rather, the inner crevice (1a) portion of the die pad 1 is clearly less thick than the outer portion of the die pad 1.

Huang 171 is not alleged to disclose the above features, nor does it.

Consequently, the Noriyuki/Huang combination fails to establish a *prima facie* case of obviousness for claim 55 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claims 56, 57, 59-64, 68 and 70 depend from claim 55 and inherently contain the features of claim 55. Thus, these claims are also allowable over the Noriyuki/Huang combination at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

Claims 58, 66, 67 and 133 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noriyuki in view of Huang 171 and further in view of U.S. Patent Application Publication 2002/0113305 to Huang ("Huang 305"). The applicant disagrees.

Claims 58, 66, 67 and 133 depend from claim 55, and inherently contain the features of claim 55. Huang 305 is not alleged to teach the features of claim 55 that Noriyuki and Huang 171 fail to teach, nor does it teach those features. Consequently, these claims are also allowable over the Noriyuki/Huang 171/Huang 305 combination at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noriyuki in view of Huang 171 and further in view of U.S. Patent No. 6,177,718 to Kozono ("Kozono"). The applicant disagrees.

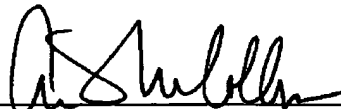
Claim 69 depends from claim 55, and inherently contains the features of claim 55. Kozono is not alleged to teach the features of claim 55 that Noriyuki and Huang 171 fail to teach, nor does it teach those features. Consequently, claim 69 is also allowable over the Noriyuki/Huang 171/Kozono combination at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

Conclusion

For the above reasons, reconsideration and allowance of claims 55-64, 66-70 and 133 is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

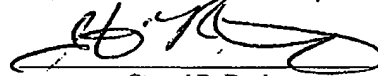


Alan T. McCollom

Reg. No. 28,881

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
Customer No. 20575

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Stormi R. Davis